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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/466,813
Filing Date: December 20, 1999
Appellant(s): KUMAGAI ET AL.

Glenn Barrett, Reg. No. 38,705
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/18/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is substantially correct, however it should be noted that the Examiner is now objecting to claim 7.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-4, 6-14, and 16-24 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,449,657	STANBACH JR. et al.	9-2002
6,360,221	GOUGH et al.	3-2002
6,014,502	MORAES	1-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6, 8-13, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al..

As to claim 1, Stanbach teaches an SMTP server arranged to send an electronic mail having a an intended recipient to a server that receives and manages the mail (col. 9, lines 26-42), comprising: an advertisement information memory operable to store advertisement information to be added to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); a user information memory operable to store a plurality of mail addresses and a plurality of pieces of personal information about users for the plurality of mail addresses so as to be associated with each other, respectively (col. 9, lines 42-67 and col. 10, lines 1-14); an advertisement information detector operable to detect the advertisement information which is to be added to the mail that is associated with at least one of user information about a user having the recipient mail address, user information about a user having a sender mail address and a sentence included in the mail (col. 10, lines 15-39); an advertisement information adding portion operable to add at least the advertisement information, which is detected from the memory by said advertisement information detector to the mail (col. 14, lines 31-47); and a sending portion operable to send the

mail, on which the advertisement information is added by the advertisement information adding portion, to the server (col. 10, lines 64-67 and col. 11, lines 1-10); however Stanbach does not teach an advertisement refusal system.

Gough teaches a mail system comprising: an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement; and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a email advertisement system with the teachings of Gough regarding an advertisement refusal option because such a service could be profitable (Gough col. 6, lines 12-39).

As to claim 2, Stanbach teaches the SMTP server of claim 2, wherein the advertisement information includes page-specifying information that specifies a predetermined homepage (col. 14, lines 30-47).

As to claim 3, Stanbach teaches the SMTP server of claim 2, wherein the advertisement information memory stores the advertisement information and personal information about a user who is an object for which addition of said advertisement information is performed so as to be associated with each other (col. 11, lines 11-34), the advertisement information detector detects the personal information associated with the mail address of the recipient of the mail from the user information memory (col. 11, lines 11-22), and detects the advertisement information

associated with said detected attributed information from the advertisement memory (col. 11, lines 11-50).

As to claim 4, Stanbach teaches the SMTP server of claim 3, wherein the attribute information is at least one of age, gender and a zip code (col. 12, lines 17-39).

As to claim 6, Stanbach teaches the SMTP server of claim 5, further comprising a target key word memory, operable to store the advertisement information and a key word to be included in a sentence of a mail to which said advertisement information is added, so as to be associated with each other (col. 11, lines 23-34), wherein the advertisement information detector detects advertisement information that is associated with a key word corresponding to a phrase included in a sentence of the mail to be sent (col. 11, lines 23-34).

As to claim 8, Stanbach teaches an SMTP server wherein the mail has plurality of mail addresses of recipients, the sending portion sends the mail to each of the mail addresses of the recipients when the mail has the plurality of mail addresses of the recipients (col. 10, lines 64-67 and col. 11, lines 1-22), the advertisement information detector detects the advertisement information to be added to the mail that is to be sent to each of the mail addresses (col. 11, lines 11-34), based on the attribute information of the user corresponding to each of the mail addresses (col. 11, lines 11-22), and the advertisement information to the mail that is sent to each of the mail addresses of the recipients (col. 11, lines 11-50).

As to claim 9, Stanbach teaches an SMTP server comprising: a point information memory operable to store a mail address and point information for a user having said mail address to be associated with each other; and a point updating portion operable to update the point information associated with the mail address of the sender of the mail, when the

advertisement information adding portion adds the mail to the advertisement information (col. 14, lines 48-62).

As to claims 10-13, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 10-13 are rejected on the same basis as claims 1-6.

As to claims 15-17, Stanbach's invention could be embodied as a POP server (col. 9, lines 26-42). All other limitations from claims 15-17 are rejected on the same basis as claims 6-9.

As to claim 18, its limitations are featured in claim 1, thus it is rejected on the same basis as claim 1.

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,449,657 to Stanbach, Jr. et al. in view of U.S. Patent Number 6,360,221 to Gough et al. and U.S. Patent Number 6,014,502 to Moraes.

As to claim 19, Stanbach teaches a mail processing system comprising a mail server operable to send a mail having a recipient mail address of an intended recipient to a server that receives and stores the mail, wherein the mail server includes: an advertisement information memory operable to store advertisement information to be added to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); a user information memory operable to stored a plurality of mail addresses and a plurality of pieces of personal information about users for the plurality of mail addresses so as to be associated with teach other (col. 9, lines 42-67 and col. 10, lines 1-14), respectively; an advertisement information detector operable to detect advertisement information, which is to be added to the mail that is associated with at least one of: (a) user

information about a user having recipient mail address, (b) user information about a user having a sender mail address corresponding to a sender of the mail, and (c) a portion of a message in the mail from the advertisement information memory; an advertisement information adding portion operable to add the advertisement information, which is detected from the advertisement information memory by said advertisement information detector, to the mail (col. 11, lines 63-67 and col. 12, lines 1-16); and a sending portion operable to send the mail, to which the advertisement information is added by said advertisement information adding portion, to the server, wherein the server includes: a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 10, lines 64-67 and col. 11, lines 1-10); however Stanbach does not explicitly teach a client program for requesting the addition of advertisement information to emails, an advertisement refusal system, a web server including a reception portion operable to send the mail to the server, or a web server operable to send a predetermined program to a terminal based on a request from the terminal.

Gough teaches a program on a terminal, from which the adding request is received, so that the mail, which is to be sent to the recipient mail address from the terminal, is sent to the mail server that adds the advertisement and a web server including a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.).

Gough teaches a mail system comprising: an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement; and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding portion to the mail, in a case

where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

Moreas teaches a web server operable to send a predetermined program to a terminal based on a request from the terminal (col. 10, lines 44-64).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Gough regarding the requesting that a server make additions to email at a server because requesting that information be added to an email increases the enjoyment of email experiences (Gough col. 1, lines 53-67 and col. 2, lines 1-5). It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a email advertisement system with the teachings of Gough regarding an advertisement refusal option because such a service could be profitable (Gough col. 6, lines 12-39). It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Stanbach regarding a system for inserting advertisements in an email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42).

As to claim 20, Stanbach teaches a mail processing system, wherein the advertisement information adding portion of the mail server adds to the mail, advertisement information including user specifying information that specifies a user of the mail, address of the recipient of the mail, and link information that makes the terminal used by the user send the user specifying

information to the web server when an instruction by the user occurs (col. 14, lines 48-62), the web server or the mail server includes a point information memory operable to a mail address, and point information of a memory operable to a mail address, and point information of a user having said mail address to be associated with each other (col. 10, lines 64-67 and col. 11, lines 1-10), the web server further includes: a user specifying information receiving portion operable to receive the user specifying information sent from the terminal by the link information sent from the terminal by the link information; and a point updating portion operable to update, based on the user specifying information received by the user specifying information receiving portion, the point information of the corresponding user (col. 10, lines 64-67 and col. 11, lines 1-10).

As to claim 21, Stanbach teaches a mail processing system wherein the advertisement information adding portion in the mail server adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information, and link information that makes a terminal used by the user having the mail address of the recipient of the mail send the advertisement specifying information to the web server when an instruction of said user occurs (col. 10, lines 64-67 and col. 11, lines 1-10), the web server or the mail server includes a charging information memory operable to store information specifying an advertiser and charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), the web server further includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); and a charging information updating portion operable to update based on the advertisement specifying information received by the

advertisement specifying information receiving portion, the charging information of a corresponding advertiser (col. 14, lines 63-67 and col. 15, lines 1-12).

As to claim 22, Stanbach teaches a mail processing system wherein the web server or the mail server includes a charging information memory operable to store advertisement specifying information that specifies an advertiser, charging information about charging on said advertiser (col. 14, lines 63-67 and col. 15, lines 1-12), and address information of an advertisement homepage to be presented to a user of a terminal, so as to be associated with one another, the advertisement information adding portion adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information (col. 14, lines 30-47), and link information that makes the terminal send the advertisement specifying information to the web server in a case where an instruction of the user of the terminal occurs, the web server includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 10, lines 64-67 and col. 11, lines 1-10); an instruction information memory controller operable to control the terminal that sent the advertisement specifying information, to store instruction information indicating that an instruction by the user occurred (col. 10, lines 64-67 and col. 11, lines 1-10); and a homepage retrieval controller operable to detect, based on the advertisement specifying information received by the advertisement specifying information received by the advertisement specifying information receiving portion, the address information of the advertisement homepage associated with the advertisement specifying information and to control the terminal to retrieve the advertisement homepage having said address information (col. 14, lines 30-47).

As to claim 23, Moreas teaches a confirmation receiving portion operable to receive confirmation that the instruction information is stored in a terminal that requested a pre-determined target homepage that is linked to the advertisement homepage (col. 6, lines 41-65); and a goal achievement charging updating portion operable to update, based on receipt of the confirmation, the charging information associated with an advertisement specifying information of an advertiser of the target homepage indicated by the confirmation (col. 6, lines 41-65).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,014,502 to Moraes and U.S. Patent Number 6,449,657 to Stanbach, Jr. et al..

As to claim 24, Gough teaches a method for enabling a terminal to send mail, comprising: receiving a request to add advertisement information to a mail from the terminal by a web server and a program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds advertisement information to the mail (col. 4, lines 1-21, The user requests that "enhancements" be added to the mail at the server.) and an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement; and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39); however Gough does not explicitly teach sending a program to a terminal and installing that program or the advertisement information being associated with at least one of user information or a portion of a message in the mail.

Moreas teaches sending an email program to a terminal and installing that program (col. 10, lines 44-64).

Stanbach teaches adding advertisement information associated with a portion of a message in an e-mail (col. 9, lines 56-67 and col. 10, lines 1-14).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the requesting that a server make additions to email at a server with the teachings of Moreas regarding a server carrying out a request for a program from a terminal because sending a program to a user facilitates the use of an email advertisement system (Moreas col. 10, lines 37-42). It would have been further obvious to one of ordinary skill in the Computer Networking art to combine the teachings of the Gough-Moreas combination regarding a program for adding advertisement information to e-mails with the teachings of Stanbach regarding associating advertisement information with a portion of a message because such a technique better provides more targeted advertising (Stanbach, col. 11, lines 35-63).

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11) Response to Argument

Appellant's arguments with the Appeal Brief filed 4/29/2004 have been fully considered. The appellant argues the following points: (a) Gough does not teach or suggest an addition refusal information memory that is operable to store addition refusal information according to an

intention of the recipient; and (b) No combination of Stanbach and Gough teaches or suggests an SMTP server that includes a non target keyword memory for storing a keyword to be included in a sentence of a mail to which an advertisement is not to be added and that the advertisement information detector removes the advertisement information associated with the keyword as in claim 7; (c) Gough does not teach or suggest a POP server that includes an addition refusal information memory that is operable to store addition refusal information according to an intention of the recipient.

As to point (a), in the system taught by Gough, if it is the intent of the user to refuse advertisements the user can pay for a membership, as in column 6, lines 30-33, and advertisements can be omitted. The web server that hosts the member sign-up web page inherently has a memory that stores the membership and the addition refusal information that can correspond to the membership as illustrated by column 6, lines 30-33. The fact that the ability to omit advertising for paid membership could be part of a set package of blanket services is irrelevant because none of the claim language specifies that the refusal information memory is a stand-alone service. Therefore Gough teaches the addition refusal information memory that is operable to store addition refusal information according to an intention of the recipient as claimed by the appellant.

As to point (b), claim 7 is now objected to by the Examiner.

As to point (c), Gough is not relied upon to teach or suggest a POP server. Stanbach shows this limitation at col. 9, lines 26-42.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully Submitted,

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November 8, 2004

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